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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,648	05/14/2001	Amy J. Donnan	DON0002/US/2	8779

7590

01/30/2002

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EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/854,648

Applicant(s)

DONNAN, AMY J.

Examiner

Dmitry Suhol

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 4, the structural limitations encompassed by the phrase "corresponding" can't be determined, rendering the claim indefinite.

Regarding claim 6, the structural features encompassed by the phrase "tear drop-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 7, the structural features encompassed by the phrase "sun-shaped" can't be determined.

Regarding claim 8, the structural features encompassed by the phrase "fire-shaped" can't be determined, rendering the claim indefinite. There is no antecedent basis for "the mad play piece".

Regarding claim 9, the structural features encompassed by the phrase "ghost-shaped" can't be determined, rendering the claim indefinite. There is no antecedent basis for "the scared play piece".

Regarding claim 10, the structural features encompassed by the phrase "heart-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 11, the structural features encompassed by the phrase "plush, pillow bag" can't be determined, rendering the claim indefinite.

In view of the examples above, the applicant is required to carefully review all of the claims in order to correct those having the same defects but not specifically pointed to.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaver. Shaver discloses an interactive toy containing all the elements of the claims including, a plurality of play pieces as required by claim 1 (figs. 9a-9j, 10a-10g, 11a-11j, and 12a-12j), a container comprising a storage chamber as required by claim 1 (fig. 1), each play piece comprising one or more unique indicia as required by claim 2 (figs. 9a-9j, 10a-10g, 11a-11j, and 12a-12j), the indicia color scheme, graphic information and text information as required by claim 3 (figs. 9a-9j, 10a-10g, 11a-11j, and 12a-12j), a first play piece corresponding to love, a second play piece corresponding to sad, a third play piece corresponding to happiness, a fourth play piece corresponding to mad, and a fifth play piece corresponding to being scared as required by claim 4 (figs. 10a-10g) and the container being a plush, pillow bag as required by claim 12 (col. 3, lines 36-43).

Shaver further discloses a method for exploring emotional experience including providing a toy and interacting with the toy as required by claims 13 and 14 (col. 4, lines 25-29), it is inherent that the play piece would be withdrawn from the container as required by claim 15, and naming the emotion corresponding to a play piece as required by claim 16 (col. 5, lines 14-41).

Claims 1, 4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Frampton. Frampton discloses an interactive toy containing all the elements of the claims including, a plurality of play pieces as required by claim 1 (fig. 1, elements 61), a container comprising a storage chamber as required by claim 1 (fig. 1, element 64), a first play piece corresponding to love, a second play piece corresponding to sad, a third play piece corresponding to happiness, a fourth play piece corresponding to mad, and a fifth play piece corresponding to being scared as required by claim 4 (fig. 5), a sad play piece being a tear drop shape as required by claim 6 shown in figure 5, the element in the lower left hand corner, a happy play piece being a sun shape as required by claim 7 is shown in figure 5, element 72, a mad play piece being a fire shape as required by claim 8 (fig. 5, element 75) and a scared play piece being in a ghost shape as required by claim 9 (fig. 5, element in the lower right hand corner).

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fredericks. Fredericks discloses an interactive toy containing all the elements of the claims including, a plurality of play pieces as required by claim 1 (fig. 1, elements 50

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and 54), a container comprising a storage chamber as required by claim 1 (fig. 1, element 10) and the play pieces comprising one or more panels enclosing a stuffing material (col. 3, lines 11-19).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaver. Although shaver discloses most the elements of the claims as stated above including the second, third, fourth and fifth play pieces comprising a respective unique color scheme as required by claim 5 (col.4, lines 58-59). The reference fails to mention the first play piece comprising a color scheme that includes a combination of the color schemes of the second, third, fourth and fifth play pieces as required by claim 5, and the container being heart shaped. However, it would have been obvious, to one having ordinary skill in the art, at the time of the claimed invention to manufacture the device of Shaver with a first play piece comprising a color scheme that includes a combination of a color scheme of the second, third, fourth and fifth play pieces and a heart shaped container for the purpose of interest to the child. The color schemes and the shape of the container are an obvious choice of design in as much as the applicant discloses no advantage or critical need for them.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS  
PRIMARY EXAMINER  
SPE 3712

ds  
January 24, 2002